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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058047
Party	Plaintiff 2156775 Ontario Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

2156775 ONTARIO INC.,

Petitioner,

v.

GI GROUP, INC.,

Respondent.

Cancellation No. 92058047

Registration No. 3,624,412

Mark: STARZ

**TRIAL BRIEF OF PETITIONER  
2156775 ONTARIO INC.**

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## I. INTRODUCTION

Petitioner, 2156775 Ontario Inc., has filed U.S. Trademark Application Serial No. 77533277 (“Petitioner’s Application”) to register the mark STAR (“Petitioner’s Mark”) for beer. In an office action dated July 8, 2010, the U.S. Patent and Trademark Office finally refused registration of Petitioner’s Mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing, *inter alia*, Registration No. 3,624,412 (“Respondent’s Registration”) for the mark STARZ (“Respondent’s Mark”) for beer, ale, lager, stout, porter, and shandy. Petitioner has appealed the final refusal to register Petitioner’s Mark, and that appeal has been suspended pending the disposition of this proceeding. Respondent’s Registration is now the sole obstacle to the registration of Petitioner’s Mark.

Respondent’s Registration was issued pursuant to U.S. Trademark Application Serial No. 77475910, which was filed May 15, 2008 (“Respondent’s Application”). In a statement of use filed on March 5, 2009, Respondent claimed to have used Respondent’s Mark in commerce on or in connection with all of the goods identified in Respondent’s Application.

Petitioner seeks to cancel Respondent’s Registration on the ground that Respondent’s Registration is void, because Respondent did not use Respondent’s Mark in commerce prior to filing the statement of use in Respondent’s Application.<sup>1</sup>

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<sup>1</sup> Petitioner has pleaded fraud as an independent ground for cancellation, but elects not to pursue that ground.

## II. DESCRIPTION OF THE RECORD

The record in this case consists of:

1. The file of Petitioner's Application.
2. The file of Respondent's Registration.
3. Petitioner's Notice of Reliance and Exhibit A thereto.

## III. ISSUE PRESENTED

The sole issue to be decided by the Board is whether Respondent's Registration is void, because Respondent failed to use Respondent's Mark in commerce before filing the statement of use in Respondent's Application.

## IV. ARGUMENT

### A. Petitioner Has Standing to Maintain This Action.

Registration of Petitioner's Mark has been refused in view of Respondent's Registration. Petitioner therefore has standing to maintain this action. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029-30, 213 USPQ 185, 189 (CCPA 1982).

### B. Respondent's Registration Is Void, Because Respondent Failed to Use Respondent's Mark in Commerce before Filing the Statement of Use in Respondent's Application.

It is settled law that the mere shipment of goods by a manufacturer to the owner of a mark affixed to the goods is not a bona fide use of the mark in commerce. *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097-98, 226 USPQ 435-36 (Fed. Cir. 1985); *Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013). "At the very least," the trademark owner must make "an open and notorious public offering of the [goods] to those for

whom the [goods] are intended.” *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 507 (TTAB 1977).

Respondent’s answers to Petitioner’s discovery requests prove that Respondent failed to make the required use of Respondent’s Mark in commerce before filing the statement of use in Respondent’s Application. In fact, Respondent has admitted that, even as of July 29, 2014, the date of its responses to Petitioner’s discovery requests, it had not sold ale, stout, porter, or shandy in commerce. See Exhibit A to Petitioner’s Notice of Reliance, Respondent’s Answers to Petitioner’s Interrogatory Nos. 5, 13, 17, and 21, and Respondent’s Answers to Petitioner’s Requests for Production Nos. 3, 7, 9 and 11.

With regard to beer and lager, Respondent mistakenly relies on a shipment of goods to Respondent by its manufacturer, High Falls Brewery, and marketing efforts by Respondent prior to the filing date of Respondent’s statement of use. See Exhibit A to Petitioner’s Notice of Reliance, Respondent’s Answers to Petitioner’s Interrogatory Nos. 1-4. These activities do not qualify as use in commerce. *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097-98, 226 USPQ 435-36 (Fed. Cir. 1985); *Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 507 (TTAB 1977).

According to Respondent, the first use of Respondent’s Mark in commerce in connection with the sale of any goods by Respondent occurred on September 23, 2009, well after the filing date of Respondent’s statement of use, March 5, 2009.

## V. CONCLUSION

As Respondent failed to use Respondent's Mark in commerce before filing the statement of use in Respondent's Application, Respondent's Registration is void and should be cancelled.

Respectfully submitted

Date: March 10, 2015



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## CERTIFICATE OF SERVICE

I certify that a copy of the foregoing document was mailed to Respondent's attorney of record on March 10, 2015, by first class mail, postage prepaid, at the following address:

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